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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/425,517 10/22/99 BHALAKIA

S 589.063US1

EXAMINER

MM92/0922

MARK A. LITMAN & ASSOCIATES, P.A.
YORK BUSINESS CENTER, SUITE 205
3209 WEST 76TH ST.
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SCHWARTZ, J PAPER NUMBER

2873
DATE MAILED:

09/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/425,517

Applicant(s)

BHALAKIA ET AL.

Examiner

Jordan M. Schwartz

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2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuler.

Schuler reads on these claims by disclosing the limitations therein including the following: an ophthalmic element comprising an injection-molded polymeric ophthalmic lens (Figure 1, re "2" as the ophthalmic lens, column 5, lines 57 and column 7, line 12 re "injection-molded", column 6, line 62 re "polymeric"). Schuler states that the concave surface is formed in a variety of diopters to provide the required optical correction

(column 3, line 37). Therefore, the concave surface of element "2" is providing the optical correction and thus element "2" can be considered as the "ophthalmic lens". Schuler further discloses a laminate bonded to the ophthalmic lens (Figure 2, "1" as the laminate); the laminate comprising first and second resinous layers (Figure 1, "6", column 6, line 68 and column 4, lines 44-68); and a functional light polarizing layer between (Figure 1, "4" and column 6, line 66); and the first resinous layer bonded to the convex surface of the lens (Figure 1, re "6" bonded to "2"). Schuler further discloses the first resinous layer directly bonded to the convex surface of the lens (Figure 1, re "6" directly bonded to "2") and the polymeric ophthalmic lens having an ophthalmic prescription power (column 3, line 37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8, 10-12, 14-15, 17-19 and 21-22 are rejected under 35

U.S.C. 103(a) as being unpatentable over Murata et al in view of Schuler.

In reference to claim 1, Murata et al discloses the limitations therein including the following: an ophthalmic element comprising an injection-molded polymeric ophthalmic lens (Figures 1-2 and abstract re "6" as the ophthalmic lens, abstract re "6" as injection-molded and polymeric). Murata et al further discloses a laminate bonded to the ophthalmic lens (Figures 1-2, "2", "3" and "5" as the laminate); the laminate comprising a

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first resinous layer (Figures 1-2 and column 2, line 49, "5" as the first resinous layer); a second resinous layer (Figures 1-2 and column 2, line 46, "2" as the second resinous layer) and a functional light polarizing layer between (Figures 1-2 and column 2, line 60, "3" as the functional layer); and the first resinous layer bonded to the convex surface of the lens (Figures 1-2 and column 2, line 53).

Murata discloses as is set forth above and further discloses the lenses being used for eyeglasses (column 3, line 45) therefore element "6" can be considered as the "ophthalmic lens". Regardless, Schuler teaches that in an optical element comprising a polarizing film sandwiched between resinous layers in which one of the resinous layers is bonded to the convex surface of an element (Figure 1), that the concave surface of the element can be imparted with the prescriptive refractive power (column 3, line 37) i.e. that the element can be an ophthalmic lens. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to impart refractive power to the concave surface of element "6" of Murata whereby element "6" would be in the form of a prescriptive ophthalmic lens since Schuler teaches of imparting the refractive power to this surface to provide the desired prescriptive requirements of the polarized corrective ophthalmic lenses.

Murata further discloses the polymeric ophthalmic lens comprising a polycarbonate resin (abstract, "6" as polycarbonate); the first resinous layer directly bonded to the convex surface of the lens (Figures 1-2 and column 2, line 53); the first resinous layer adhesively bonded to the polymeric ophthalmic lens (column 2, line 53). Applicant further claims that the ophthalmic lens can either have prescriptive power

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(which is taught by the Schuler reference as set forth above) or not have prescriptive power which is apparently what is disclosed in the Murata et al reference. Regardless, since applicant has set forth no critical reason for the ophthalmic lens either having prescriptive power or not having prescriptive power, these features solve no stated problem and are therefore an obvious matter of design choice to one of ordinary skill in the art. In re Kuhle, 188 USPQ 7 (CCPA 1975).

Double Patenting

Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 5,827,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are claiming laminating a polarizing or photochromic functional layer sandwiched between resinous layers to the surface of a polymeric ophthalmic lens.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

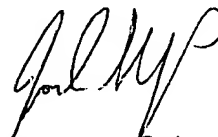
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached between 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz
Patent Examiner
Art Unit 2873
September 20, 2000